

REMARKS

Claims 1-23 are all the claims pending in the application. Claims 9, 11 and 12 have been amended for purposes of further clarity.

Entry of the above amendments is respectfully requested.

I. Response to Nonstatutory Double Patenting Rejection of Claims 1-15, 22 and 23

Claims 1-15, 22 and 23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 10-24 of copending Application No. 10/765,929 in view of Hanaki et al. (US 2005/0073563).

Without acquiescing in the merits of the rejection, the Examiner is respectfully requested to hold the provisional obviousness-type double patenting rejection in abeyance, until one or the other co-pending application is otherwise in condition for allowance.

In view of the above, withdrawal of the obviousness-type double patenting rejection is respectfully requested.

II. Response to Rejection of Claims 9, 11 and 12 under 35 U.S.C. § 112, second paragraph

Claims 9, 11 and 12 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being incomplete for omitting essential elements. The Examiner indicates that claim 1 recites "structural units of repeated Y comprise at least one structural unit represented by A, C or D," and claims 9, 11 and 12 claim A, C and D independently. Thus, the Examiner asserts that claims 9, 11 and 12 are not all necessarily part of the invention.

Applicants respectfully traverse the rejection.

Claim 1 recites "structural units of repeated Y comprise at least one structural unit represented by A, C or D." Thus, Y can comprise A, C or D individually or various combinations of A, C and D. Claims 9, 11 and 12 each independently depend from claim 1. Claim 9 limits claim 1 by further defining A, claim 11 limits claim 1 by further defining C and claim 12 limits claim 1 by further defining D. Thus, for example, claim 9 covers an ink jet recording ink when Y comprises structural unit A, which is derived from vinyl alcohol, α -methylvinyl alcohol, or α -propylvinyl alcohol. Since each of claims 9, 11 and 12 depend directly from claim 1, these claims independently define structural units A, C and D, respectively, which is permitted. A dependent claim may state additional limitations or further define any element in an independent claim or other dependent claim.

For the above reasons, it is respectfully submitted that claims 9, 11 and 12 comply with 35 U.S.C. §112, second paragraph.

However, to advance prosecution, claims 9, 11 and 12 have been amended to specifically recite that Y comprises the specific structural unit set forth in each claim for purposes of further clarity.

In view of the above, withdrawal of the rejection is respectfully requested.

III. Response to Rejection of Claims 1-11, 13-15, 17, 18, 22 and 23 under 35 U.S.C. §103(a)

Claims 1-11, 13-15, 17, 18, 22 and 23 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kubodera (JP 10-95942) in view of Aoshima (U.S. Patent 6,068,963).

Applicants respectfully traverse the rejection.

The present invention according to claim 1 is an ink-jet recording ink comprising a pigment and a compound represented by General formula (I).

The Examiner recognizes that Kubodera does not disclose a pigment or X representing a bivalent linking group having a hetero bond or the hetero bond selected from the group consisting of an ether bond, an ester bond, a thioether bond, a thioester bond, a sulfonyl bond, an amide bond, an imide bond, a sulfonamide bond, a urethane bond, a urea bond and a thiourea bond. To make up for the deficiencies, Aoshima is cited as teaching a pigment and X, which represents a bivalent linking group having a hetero bond or the hetero bond selected from the group consisting of an ether bond, an ester bond, a thioether bond, a thioester bond, a sulfonyl bond, an amide bond, an imide bond, a sulfonamide bond, a urethane bond, a urea bond and a thiourea bond (*see* col. 15, lines 46-55 and col. 3, lines 33-51).

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation in the references or in the knowledge of one of ordinary skill in the art to combine reference teachings.

In this case, it is respectfully submitted that there is no motivation to combine Kubodera and Aoshima. Kubodera is directed to a recording liquid containing a water-soluble dye. Thus, the ink of Kubodera is a dye-based ink.

Aoshima relates to an image recording material. Specifically, Aoshima discloses that the invention relates to image recording materials which may be used as planographic printing plate materials, color proofs, dry lith type film, photo resists, or color filters. Thus, Aoshima is mainly directed to a printing plate, and its object is related to a printing plate, not to inks. *See* Abstract and Summary of Invention. Accordingly, Kubodera and Aoshima are directed to different technical fields, and one of ordinary skill in the art would not be motivated to use the pigments disclosed in Aoshima in the ink of Kubodera.

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In addition, since the invention of Kubodera relates to a recording liquid containing a water-soluble dye, one of ordinary skill in the art would not be motivated to add pigments to the dye-based ink of Kubodera to arrive at the present invention.

Furthermore, the description of L₁ at column 3, lines 33-51 of Aoshima relied upon by the Examiner relates to a side chain, and thus does not correspond to X in formula (I) of claim 1.

For the above reasons, it is submitted that one of ordinary skill in the art would not have been motivated to combine the references, and that claims 1-11, 13-15, 17, 18, 22 and 23 are patentable over Kubodera and Aoshima.

Accordingly, withdrawal of the rejection is respectfully requested.

IV. Response to Rejection of Claims 12, 16, 19 20 and 21 under 35 U.S.C. § 103(a)

Claims 16 and 20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kubodera and Aoshima, in further view of Aono et al. (JP 07-219113).

In addition, claim 19 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kubodera and Aoshima, in further view of Yamanouchi et al. (U.S. 2002/0143079).

Further, claim 21 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kubodera and Aoshima, in further view of Nishita (U.S. 2002/0060727).

Applicants respectfully traverse the rejection. Each of claims 16, 19 and 20-21 depend from claim 1, and thus, it is respectfully submitted that these claims are patentable for at least the same reasons as claim 1.

Accordingly, withdrawal of the rejections is respectfully requested.

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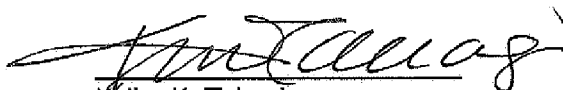
V. Conclusion

For the foregoing reasons, reconsideration and allowance of claims 1-23 is respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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